

REPLY UNDER 37 CFR – 1.116 – EXPEDITED PROCEDURE TECHNOLOGY  
CENTER 1794

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 1794	Customer No. 035811
Examiner	: Alicia Anne Chevalier	
Serial No.	: 10/509,269	Docket No.: TOR-04-1238
Filed	: September 27, 2004	
Inventors	: Mahito Kawano	Confirmation No.: 5364
	: Kiyoshige Maeda	
Title	: LAMINATED FILM,	
	: FILTER FOR DISPLAY,	
	: AND DISPLAY	

Dated: November 13, 2009

**RESPONSE**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is submitted in response to the Official Action dated September 17, 2009.

Claims 1-6 and 11-21 stand rejected under 35 USC §103 over the hypothetical combination of Murata and Yamada with Oka. The Applicants note with appreciation the Examiner's detailed comments hypothetically applying the combination against those claims. The Applicants nonetheless respectfully submit that one skilled in the art would not make the hypothetical combination, but in any event, the hypothetical combination would still result in a different multi-layer film from what the Applicants claim. Details are set forth below.

The Applicants will address these details in two portions, namely a portion directed to the "Answers to Applicants' Arguments" section of the Official Action and toward problems with the combination of Oka and Murata, and the combination of Oka and Yamada.

Turning first to the "Answers" section, the Applicants respectfully submit that the Applicants' claimed average surface roughness Ra of 0.004 to 0.020  $\mu\text{m}$  is anything but obvious

over the hypothetical combination. In that regard, the rejection states that “the Examiner acknowledges that the range disclosed in Murata is slightly outside of the claimed range.” The Applicants disagree with this characterization of the differences between the Applicants’ claims and Murata (cited for support for the surface roughness of the resin layer (d)). In particular, the Applicants do not believe that the Murata range is “slightly” outside of the claimed range. The Murata range is 0.03 to 0.30  $\mu\text{m}$  and the Applicants’ claimed range is 0.004 to 0.020  $\mu\text{m}$ . The gap between these two ranges comes from the Applicants’ upper end of 0.020 and Murata’s lower end of 0.03. Although both numbers are relatively small as measured in microns, it should be noted that the lowest end point of Murata is 50% higher than the upper range of the Applicants’ surface roughness. The Applicants therefore respectfully submit that a 50% difference between the highest point and the lowest point is anything but a “slight” difference. This is actually a large gap between the two.

This rather large gap becomes particularly important when the teachings of Murata are taken as a whole. In that regard, the rejection also again isolates a portion of the Murata disclosure from consideration of surrounding text. In particular, the rejection refers only to column 3, lines 61-64. While that portion of the Murata disclosure is quite relevant, it is not the only relevant portion. This was highlighted in the Applicants’ previous Response by specifically quoting adjacent language in the text spanning pages 7 and 8 of that Response. Taking that disclosure as a whole is the only fair way to interpret the teachings of this reference.

In any event, even if column 3, lines 61-64, is taken in a vacuum, it is not helpful in establishing the exact surface roughness as a result effective variable upon which the obviousness rejection can be based. That is because that portion of the text specifically states that, among other things, “no sufficient antiglare effect can be exhibited when Ra is smaller than

0.03  $\mu\text{m}$ .” This is an important teaching with respect to the requirements of establishing obviousness. In establishing obviousness, it is not only necessary for the prior art to provide motivation for those skilled in the art to make modifications, but there must be also a reasonable expectation that such modifications would be successful. This portion of the Murata disclosure demonstrates that one skilled in the art would not have a reasonable expectation of success. Specifically, it is an important objective of Murata to provide an antiglare material. In fact, that is the first word of the title of the Murata reference. However, column 3, lines 61-64, specifically states that if the surface roughness is less than 0.03  $\mu\text{m}$ , “no sufficient antiglare effect can be exhibited.” The Applicants respectfully submit that this is a clear teaching and warning to those skilled in the art that there would be no reasonable expectation of success in establishing the central aspect of the Murata invention to attempt to optimize the surface roughness to less than 0.03  $\mu\text{m}$ .

Moreover, this plain teaching is reinforced by the following text highlighted in the Applicants’ previous Response as mentioned above which uses the terms “essential” and “must” be within the specific cited ranges. The Applicants therefore respectfully submit that it would be in error to isolate particular portions of text of a reference without considering the entirety of that disclosure and focusing on a “result effective variable” to the exclusion of the larger considerations for obviousness with respect to reasonable expectations of success. Those skilled in the art can readily glean from Murata that straying outside of the “essential” surface roughnesses taught by Murata would likely lead to failure, not a reasonable expectation of success. Moreover, reference to the actual examples of Murata as illustrated in Table 1 reveals the problems associated with extending beyond the “essential” range of Murata. These teachings of Murata, when taken as a whole, establish the criticality associated with the range. In other

words, the prior art establishes the criticality of the range, not only on its emphatic teachings, but also based on its experimental results. Thus, the Applicants respectfully submit that Claims 1-6 and 11-21 are not obvious over the combination of Murata and Yamada with Oka since that combination would result in a multi-layer film having a surface roughness outside of the Applicants' claimed range.

However, there are additional problems with the rejection. One object of Oka is to provide antiglare-antireflection film having an antiglare property and/or an antireflection property as discussed in col. 3, lines 12 – 14. According to Murata, however, it is not possible to achieve a sufficient antiglare effect when Ra is smaller than 0.03  $\mu\text{m}$  as discussed in col. 3, lines 58 – 64. Hence, one skilled in the art would not obtain an Ra smaller than 0.03  $\mu\text{m}$ .

There are still further problems with Oka and Yamada. One object of Oka is to provide antiglare-antireflection film having an antiglare property and/or an antireflection property as discussed in col. 3, lines 12 – 14. The low refractive index layer of Oka is formed by a gas phase growth process. When the low refractive index layer is formed by coating on the antiglare layer, the material for the low refractive index layer concentrates in the recessed portions of the fine uneven surface of the antiglare layer, the surface of the low refractive index layer becomes flat. That is to say, the surface of the multi-layer film becomes flat. As a result, the antiglare effect is reduced as discussed in col. 13, lines 12 – 22.

The composition of Yamada is for coating. The composition of Yamada is not used for a gas phase growth process. If the coating composition of Yamada is coated on the high refractive index layer of Oka, the fine uneven surface of the high refractive index layer of Oka becomes flat. Therefore, one skilled in the art would not use the coating composition of Yamada as a low reflective index layer of Oka. Withdrawal of the rejection is respectfully requested.

Claim 10 stands rejected under 35 USC §103 over the further hypothetical combination of Hasuo with Murata, Yamada and Oka. The Applicants respectfully submit that Hasuo fails to provide additional disclosure that would cure the deficiency as set forth above with respect to the Murata, Yamada and Oka combination. Withdrawal of the rejection is respectfully requested.

In light of the foregoing, the Applicants respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



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